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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,846	11/25/2003	Joop Peterse	A3279	6954

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Rochester, NY 14644

EXAMINER

SIPOS, JOHN

ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/721,846

Applicant(s)

PETERSE ET AL.

Examiner

John Sipos

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 14-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-13, drawn to an air bladder, classified in Class 383, subclass 3.

Group II. Claims 14-25, drawn to a method of packaging, classified in Class 53, subclass 742.

The inventions are distinct, each from the other, because of the following reasons:

The inventions of Groups I and II are related as **product and process of using the product**. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case the air bladder of Group I can be used in a process other than the packaging process set forth in the claims of Group II. For example, the bladder can be used by placing it on the bottom of a container to provide support for a product. Furthermore, since the product claims do not recite the whole package including the tem and the box , the bladder need not even be used in a packaging process but rather n any process that may require cushioning.

Because these inventions are distinct for the reasons given above, and because they have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes, as indicated, is proper.

Applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even if the restriction requirement is traversed.

During a telephone conversation between Examiner John Sipos and Mr. R. Spooner, attorney of record in this case, on July 30, 2004, a provisional election was made with traverse to prosecute the invention of Group I, comprising claims 1-13. Affirmation of this election must be made by applicant in responding to this Office action. Claims 14-25 are withdrawn from further consideration by the examiner as being drawn to a non-elected invention. (See 37 CFR 1.142(b)). An action on the merits of the elected claims follows.

Applicant is reminded that, upon cancellation of claims to a non-elected invention, the **inventorship must be amended** in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h). Applicant should further **amend the title**, in necessary, to reflect the elected invention.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

The following is a quotation of the appropriate paragraphs of 35 U.S.C. ' 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1,6,8 and 11 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Harreld (4,486,975). The patent to Harreld shows an air bladder comprising of a center body (see numeral 11), a plurality of essentially tubular fingers 12,13 connected to the center body and valve means 24 to inflate the center body and fingers. The position of the air bladder in a package and relative an item is given little patentable weight since it is merely a recitation of intended use while the claim is directed to "An air bladder". The structure of the item and box are not part of the claim or the structure of the air bladder.

Claims 1,2,4,6,8,9 and 11 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Lemelson (4,179,832). The patent to Lemelson shows an air bladder comprising of a round center body 43, a plurality of essentially tubular fingers 38-42 connected to the center body and a plurality of valve means on the fingers to inflate the center body and fingers (see column 5, line 19 et seq.). The position of the air bladder in a package and relative an item is given little patentable weight since it is merely a recitation of intended use while the claim is directed to "An air bladder". The structure of the item and box are not part of the claim or the structure of the air bladder.

Claims 1-4,6,7,11 and 13 are rejected under **35 U.S.C. ' 102(b)** as being anticipated by the patent to Aninger (3,398,501). The patent to Aninger shows an air bladder comprising of a round center body 12, a plurality of essentially tubular fingers 14 connected to the center body and valve means 18 on one finger to inflate the center body and fingers. Regarding claim 13, the "seam" is read on the base lines of Aninger shown at the bottom of each finger where it connect to the center portion.

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The following is a quotation of 35 U.S.C. ' 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2,3,7,9,10 and 12 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Harreld (4,486,975). The use of valves on the fingers (claim 2), the use of filling tubes (claim 3), the number of fingers (claim 7), the use of plurality of valves (claim 9), the use of two way valves (claim 10), the use of biodegradable material (claim 12) and folding seams (claim 13) are well known in the art and their use would have been obvious for their known benefits.

Claims 3,5,7,10,12 and 13 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Harreld (4,486,975). The use of filling tubes (claim 3), the shape of the center body (claim 5), the number of fingers (claim 7), the use of two way valves (claim 10), the use of biodegradable material (claim 12) and folding seams (claim 13) are well known in the art and their use would have been obvious for their known benefits.

Claims 5,8-10 and 12 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Aninger (3,398,501). The shape of the center body (claim 5), the number of fingers (claim 8), the use of plurality of valves (claim 9), the use of two way valves (claim 10), the use of biodegradable material (claim 12) are well known in the art and their use would have been obvious for their known benefits.

ADDITIONAL REFERENCES CITED

The following prior art is made of record but has not been relied upon in the rejection of claims. However, the prior art is considered pertinent to applicant's disclosure.

The cited art shows air bladders with inflatable center bodies and a plurality of inflatable fingers extending from the center body.

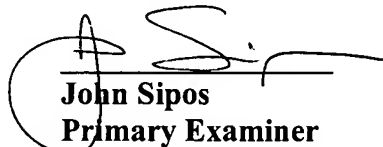
Note Presnick showing an air bladder with a plurality of valves; Pivert showing an air bladder with a filling tube and partial seam lines 250,350 along which the fingers are folded while permitting the air to pass; and Pensak showing an air bladder with a two way valve.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 872-9306**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703) 308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.


John Sipos
Primary Examiner
Art Unit 3721